

dispersion of surface stabilized polymer particles in at least one liquid fatty substance wherein said particles are particles of at least one polymer, and wherein said polymer particles are stabilized by at least one surface stabilizing polymer." See Office Action page 2.

Applicants respectfully traverse this rejection. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. The identical invention must be described in as complete detail as is contained in, and must be arranged as required by, the claim. See *M.P.E.P.* § 2131.

Applicants respectfully submit that the '095 reference fails to set forth each and every element of the claim. For example, the '095 reference fails to set forth a weight percentage of the polymer in the dispersion in accordance with the present invention. The claimed invention, on the other hand, employs polymer particles comprising at least 2% by weight relative to the total weight of the composition. Out of 12 examples, only Example 7 in the '095 reference is a composition for coating keratin fibers. This example specifies 5 grams of a "dispersion according to Example 1." See the '095 reference, column 12. Referring to Example 1, the patentee has shown that the solids content of the dispersion is 25% by weight. Hence, in Example 7, only 25% of the 5 gram dispersion, or 1.25 grams, are solid. The percentage of solid in Example 7 is therefore 1.36% based on the total weight of the composition.

Thus, it is objectively clear that the '095 reference does not anticipate the present invention because the only example capable of being used to treat keratin fiber falls

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

outside the weight percentage of solids claimed by Applicants. For at least this reason, Applicants respectfully request that this rejection be withdrawn.

Furthermore, Applicants submit that the claims recite a composition having a viscosity ranging from 2 Pa·s to 17 Pa·s, measured at 25°C and a sheer rate of 200 s⁻¹. The Office has failed to even allege that this viscosity limitation is taught by the '095 reference. Accordingly, the Office has failed to meet its burden of establishing a *prima facie* case of anticipation, and therefore request that the rejection be withdrawn for this additional reason.

III. Rejection Under 35 U.S.C. § 102(b)

The Office has rejected claims 1-13, 18, and 21-31 under 35 U.S.C. 102(b) as being anticipated by WO 98/42298 to Curtis *et al.* (the Curtis reference.) The Office alleges that the Curtis reference discloses "a wear resistant cosmetic composition which includes a styrene-ethylene/propylene mixed block copolymer in a cosmetically acceptable carrier." See Office Action page 3.

Applicants respectfully traverse this rejection. A claim is anticipated only if each and every element as set forth in the claim is taught, either expressly or inherently, in a single prior art reference. See *M.P.E.P.* § 2131. The reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992).

The claimed invention is directed to compositions and methods comprising a dispersion of surface-stabilized polymer particles in a liquid fatty phase that has a

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

viscosity ranging from 2 Pa·s to 17 Pa·s, measured at 25°C and a sheer rate of 200 s⁻¹. These limitations are neither expressly nor impliedly suggested in totality by the Curtis reference. Moreover, the Office has failed to even allege that these limitations are taught by the Curtis reference. Applicants therefore submit that the Office has failed to show how each and every limitation is taught in the Curtis reference, and request that this rejection be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a)

The Office has rejected claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over WO 98/42298 to Curtis *et al.* (the Curtis reference.) The Office contends that the Curtis discloses "a wear resistant cosmetic composition which includes a styrene-ethylene/propylene mixed block copolymer in a cosmetically acceptable carrier." See Office Action page 3..

Applicants respectfully traverse this rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met, including that the prior art teach or suggest all the claim limitations. In the present case, at least this criteria has not been met. Applicants respectfully submit that the Office has not met its burden of establishing a *prima facie* case of obviousness because the Curtis reference does not teach all limitations of the claimed invention. The compositions according to the instant invention have a viscosity ranging from 2 Pa·s to 17 Pa·s, measured at 25°C and a sheer rate of 200 s⁻¹. The Curtis reference is devoid of this limitation, and, as emphasized above, the Office has failed to even allege that this limitation is taught or suggested by the reference. Additionally, the present invention recites a surface

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

stabilized polymer, while the Curtis reference utilizes a mixed block copolymer. Nothing in the Curtis reference specifically discloses that such a mixed block copolymer is surface stabilized. Accordingly, the Curtis reference does not disclose all the limitations of the claimed invention and therefore, the claimed invention cannot be obvious in light of the reference.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 13, 2001

Shahav. Dant, Reg No. 39,004
By: *for Mark D. Sweet*
Mark D. Sweet
Reg. No. 41,469

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com